

REMARKS

Claims 1-46 are all the claims pending in the application. By this Amendment, Applicant editorially amends claims 1 and 41. The amendments to claims 1 and 41 were made for reasons of precision of language and consistency, and do not narrow the literal scope of the claims and thus do not implicate an estoppel in the application of the doctrine of equivalents. The amendments to claims 1 and 41 were not made for reasons of patentability.

In addition, by this Amendment, Applicant adds claim 46. Claim 46 is clearly supported throughout the specification (e.g., pages 15-16 of the Specification).

I. Summary of the Office Action

The Examiner objected to the Drawings, Specification and the claims. In addition, the Examiner rejected claims 1-40 under 35 U.S.C. § 103(a) and claims 41-45 under 35 U.S.C. § 102(b).

II. Information Disclosure Statement

Applicant respectfully points out that the Examiner used the prior art disclosed in the Application in a number of rejections. Clearly, the Examiner has considered the prior art disclosed in the present Application.

III. Drawings

Applicant thanks the Examiner for accepting the drawings filed on July 18, 2002. However, the Examiner has also objected to the drawings received on July 18, 2002 because

Figure 5, as alleged by the Examiner, appears to designate two reference numerals 40 and 46 to the backbone network (see page 2 of the Office Action).

However, Applicant respectfully submits that reference numeral 40 refers to the directory assistance architecture as explained in the last paragraph on page 30 of the Specification. In order to further clarify that reference numeral 40 refers to directory assistance architecture, Applicant herein amends last paragraph on page 30 of the Specification. As a result, the Examiner is respectfully requested to withdraw this objection to the Drawings.

IV. Specification

The Examiner objected to the Specification for a number of reasons. In particular, the Examiner objected to the summary of the invention, the detailed description for failing to describe a data recognition unit and a corresponding sequence, and for minor typographical errors and the title of the invention for being not descriptive.

A. Summary of the Invention

To begin, the summary of the invention is objected to for its length and for being a mere recitation of the claims (see page 3 of the Office Action). With respect to length, Applicant has shortened the Summary of the Invention (instead of seven and a half pages, the summary of the invention is now about three pages).

With respect to the Specification being the mere recitation of the claims and thus contrary to the spirit and intent of 37 C.F.R. § 1.73. Applicant respectfully disagrees. On the contrary,

the summary of the invention of the present Application is within the spirit of 37 C.F.R. § 1.73 and is supported by the requirements recited in MPEP § 608.01(e).

MPEP § 608.01(e) requires summary of the invention *to be directed to the specific invention being claimed*, emphasis added, page 600-66. Moreover, the brief summary of the invention should be more than a mere statement of the objects of the invention, which statement is also permissible under 37 C.F.R. § 1.73. *Id.* The brief summary of the invention should be *consistent with the subject matter of the claims*, emphasis added, *Id.*

In the present case, the summary of the invention is consistent with the subject matter of the claims and is directed to the invention as claimed. Neither the CFR nor the MPEP require the summary of invention to explain the language and the terms of the claims. Applicant respectfully requests the Examiner to withdraw this objection to the summary of the invention.

B. Claimed Subject Matter and the Specification

Next, the Examiner alleges that a data recognition unit as set forth in claim 1 and a corresponding sequence as set forth in claim 36 are not disclosed in the Specification (see pages 3-4 of the Office Action). Applicant respectfully disagrees with the Examiner.

With respect to a data recognition unit, *an illustrative, non-limiting* embodiment of the present invention clearly teaches a data recognition unit 20 and a speech recognition unit 22 so that the interface is able to recognize any kind of input that is likely to be sent from a telephony-enabled device (Fig. 1; page 14, lines 5-7). Moreover, exemplary details of various features of

the data recognition unit 20 is clearly disclosed in paragraph beginning on page 14 of the present Application.

Therefore, Applicant respectfully submits that the meaning of a data recognition unit for recognizing a remote data input is apparent from the descriptive portion of the specification as required by MPEP § 608.01(o). As a result, Applicant respectfully requests the Examiner to reconsider and to withdraw this objection to the specification.

With respect to the feature of “a corresponding sequence in a base language by real time automatic translation” as set forth in claim 36, Applicant respectfully requests the Examiner to withdraw the rejection in view of self-explanatory amendment made herein to the last paragraph beginning on page 27 of the Specification.

C. Minor Typographical Errors

Furthermore the Examiner objected to the Specification in view of minor typographical errors (page 4 of the Office Action). Applicant thanks the Examiner for pointing out these typographical errors. Applicant herein amends the Specification to correct these typographical errors. In view of these amendments to the Specification, Applicant respectfully requests the Examiner now to withdraw this objection.

D. Title of the Invention

Finally, the Examiner objected to the title of the invention for being not descriptive (see page 4 of the Office Action). Applicant thanks the Examiner for suggesting the title for the Application. Applicant, herein amends the title of the invention. The title, as now amended, is

somewhat similar to the one suggested by the Examiner. In view of this self-explanatory amendment to the title, Applicant respectfully requests the Examiner to withdraw this objection to the title.

V. Objection to the Claims

The Examiner objected to claims 1 and 41 because of minor informalities. In particular, the Examiner asserts that the term “via” should be replaced with the term “between” (see page 5 of the Office Action). Applicant thanks the Examiner for indicating with particularity reasons for objecting to the claims. However, Applicant respectfully disagrees.

Applicant respectfully points out that claim 1 recites “an automatic question unit”, which, for example, determines whether the user is connected through a voice based or a text based communication link or perhaps both links. If Applicant amends the claim as suggested by the Examiner “...whether a user is connected between at least one of...”, this recitation will be unclear. Claim 1, in its current form, reciting “whether the user is connected via at least one...” is clear and definite. Therefore, Applicant respectfully requests the Examiner to withdraw this objection to claim 1.

With respect to other objections to claims 1 and 41, Applicant has revised these claims and respectfully submits that claims 1 and 41 as now presented no longer include the potential other informalities mentioned by the Examiner. In particular, by this Amendment, Applicant adds a colon to claim 1 and semi-colons to claim 41. In view of these amendments and argument presented above, Applicant respectfully requests the Examiner to withdraw the objections to claims 1 and 41.

V. Claim Rejections under 35 U.S.C. § 103(a)

The Examiner rejected claims 1-40 under 35 U.S.C. § 103(a). Applicant respectfully traverses this rejection in view of the following remarks.

The initial burden of establishing that a claimed invention is *prima facie* obvious rests on the USPTO. *In re Rijckaert*, 9 F. 3d 1531, 1532 (Fed. Cir. 1993). To make its *prima facie* case of obviousness, the USPTO must satisfy three requirements:

- a) The prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated to artisan to modify a reference or to combine references. *In re Thrif*, 298 F.3d 1357, 1363 (Fed. Cir. 2002).
- b) The proposed modification of the prior art must have had a reasonable expectation of success, and that determined from the vantage point of the artisan at the time the invention was made. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209 (Fed. Cir. 1991).
- c) The prior art reference or combination of references must teach or suggest all the limitations of the claims. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, the nature of a problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Alternatively, the motivation may be implicit from the prior art as a whole, rather than expressly stated. *Id.* Regardless if the USPTO relies on

an express or an implicit showing of motivation, the USPTO is obligated to provide particular findings related to its conclusion, and those findings must be clear and particular. *Id.* A broad conclusionary statement, standing alone without support, is not “evidence.” *Id.*; *see also, In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

In addition, a rejection cannot be predicated on the mere identification of individual components of claimed limitations. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Id.*

A. Claims 1-6

The Examiner rejected claims 1-6 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,500,920 to Kupiec (hereinafter “Kupiec”) in view of U.S. Patent No. 4,579,533 to Anderson et al (hereinafter “Anderson”). Applicant respectfully traverses this rejection and respectfully requests the Examiner to reconsider in view of the following comments.

Of these claims, only claim 1 is independent. Independent claim 1 recites a number of novel and unobvious features not found in the prior art. For example, claim 1 recites:

an automatic question unit operable to
determine whether a user is connected via at
least one of a voice-based and a text-based
communication link, and for eliciting input
from a user in accordance with said
determination...
...a query formulation unit for eliciting
further input from the user.

The Examiner asserts that Anderson teaches an automatic question unit as set forth in claim 1 and that Kupiec teaches all other recitations of claim 1 including a query formulation unit. In addition, the Examiner asserts that there is motivation to combine the two references in order to keep the ROM requirement low by defaulting to eliminate non-essential programming (see pages 6-9 of the Office Action). Applicant respectfully disagrees with the Examiner. Applicant has carefully studied Kupiec and Anderson, and respectfully submits that neither of these references, either alone or in combination, teaches or suggests an automatic question unit or a query formulation unit as recited in the independent claim 1.

For example, an illustrative, non-limiting embodiment of the present invention discloses an interface which is able to determine whether the user is communicating via voice or text. This is accomplished, for example, by analyzing the initial input of the user. Alternatively, a handshake procedure (used to set up the channel) can be analyzed. For this purpose, the exemplary interface has both a data recognition unit 20 and a speech recognition unit 22 so that it is able to recognize any kind of input that is likely to be sent from a user device. If the user is using voice communication then the question unit 18 preferably communicates using voice. The questions may thus be prerecorded or they may be formulated afresh and spoken by a speech synthesis unit. If the user is using text based communication then text based versions of the questions may simply be sent to the user as text messages (Fig. 1, pages 31-32 of the Specification).

Moreover, an illustrative, non-limiting embodiment of the present invention discloses an interface which is capable of transforming input into query in a hierarchical manner. In

particular, user input is split into fields (or query items). The number of query items are analyzed to determine whether the query with only the given numbers is sufficiently strong to obtain a useful result. If not, the user is further queried with additional questions (see e.g. Fig. 2, page 28, first full paragraph of the Specification).

Kupiec teaches automatically transcribing a user question into a computer suitable form. The question is a sequence of words, such as a spoken utterance or a handwritten phrase. The question is transduced into a signal that is converted into a sequence of symbols. A set of hypotheses is generated from the sequence of symbols. The hypotheses are sequences of words represented in a form suitable for use by the computer, such as text. One or more information retrieval queries are constructed and executed to retrieve documents from a corpus (database). Retrieved documents are analyzed to produce an evaluation of the hypotheses of the set and to select one or more preferred hypotheses from the set. The preferred hypotheses are output to a display, speech synthesizer, or applications program (see *Abstract*).

On the other hand, if no candidates for the hypotheses are found, then the hypotheses generator 60 can omit an unrecognized word; alternatively, the process can be halted to prompt the user to repeat the question (col. 11, lines 1-9). In addition, Kupiec teaches that an input question 301 can be a spoken utterance, in which case transducer 220 comprises audio signal processor but if the input question 301 is a handwritten phrase than the transducer 220 is a digitizing tablet (Fig. 11; col. 24, lines 22 to 42).

However, in Kupiec, the user is requested to repeat the initial question. That is, Kupiec's system fails to teach or suggest requesting further input from the user. Moreover, in Kupiec, this

automatic transcription method fails to teach or suggest a question unit capable of determining whether the question is in a form of text or speech. Kupiec only has one transducer 220, which can only handle one type of input.

The Examiner acknowledges that Kupiec fails to teach or suggest an automatic question unit as set forth in claim 1. However, the Examiner asserts that Anderson teaches this automatic question unit (see page 7 of the Office Action). In particular, the Examiner alleges that col. 9, lines 56-64 of Anderson teaches the automatic question unit. However, col. 9, lines 56-64 of Anderson recite:

selectively providing responsive to student operator commands either a synthesized audible output of said designated word or an explanatory graphic representation of said designated word substantially immediately responsive to said student command, said audible output being representative of the spoken form of said designated word and said explanatory graphic representation being textual commentary about said designated one word.

Applicant respectfully submits that Anderson fails to cure the deficient teachings of Kupiec. To begin, Anderson teaches a microprocessor based electronic teaching aid which enables a student viewing a display containing text material being studied. The student is able to designate any word or portion of text for definition via a keypad and the definition is provided through speech or text, see *Abstract*. In particular, user inputs request by a keypad 5, which contains 12 or more keys (col. 5, line 57 to col. 6, line 16). The cursor of the keypad 5 can be moved to align to any

word on the screen to be designated for speech or definition by depressing “S” or “D”, respectively (Fig. 7; col. 8, lines 13 to 22).

In Anderson, user input is always in a form of text via keypad. Anderson fails to teach or suggest a voice-based communication link for user input. As such there is no determination of whether the user is connected via voice-based or text based communication link. This is not required because in Anderson, the only user input possible is via keypad. There is no voice-based communication link. In short, Anderson fails to teach or suggest an automatic question unit operable to determine whether a user is connected via at least one of a voice-based and a text-based communication link.

In short, Kupiec and Anderson, alone and in any combination, fail to teach or suggest an automated question unit as recited in claim 1. Thus, Applicant believes that the Examiner cannot fulfill the “all limitations” prong of a *prima facie* case of obviousness, as required by *In re Vaeck*.

Moreover, there is no motivation to combine the references in a manner suggested by the Examiner. A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See *In re Kotzab*, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (citing *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one “to fall victim to the insidious effect of a hindsight syndrome wherein that which only the

invention taught is used against its teacher.” *Kotzab*, 55 USPQ2d at 1316 (quoting *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. *In re Kotzab*, 55 USPQ2d at 1316 (citing *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998)). Thus, every element of a claimed invention may often be found in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *Id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *In re Kotzab*, 55 USPQ2d at 1316 (citing *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); and *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)).

“Although the suggestion to combine references may flow from the nature of the problem, ‘defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness.’” *Exolochem, Inc. v. Southern California Edison Co.*, 2000 U.S. App. LEXIS 22681, *28 (Fed. Cir. 2000) (citing *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 880, 45 USPQ2d 1977, 1981 (Fed. Cir. 1998)). “Therefore, when determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus obviousness, of making the combination.” *Id.* at *29-30 (citing *In re Beattie*, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992)).

Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. *In re Kotzab*, 55 USPQ2d at 1316-1317 (citing *B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996)); see also MPEP § 2142 (quoting *Ex parte Clapp*, 227 USPQ 972, 973 (B. Pat. App. & Inter. 1985)) (“To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.”).

In the present case, the Examiner asserts that one of ordinary skill in the art would have been motivated to incorporate Anderson into Kupiec so as to keep ROM requirements low by eliminating the need to program alternatives to patently obvious conditions (see page 7 of the Office Action). However, Kupiec does not even mention a ROM as part of its system for automatically transcribing an input question. Kupiec has a transducer, transcriber, CPU, display, speech synthesizer, etc. but no mention of ROM is provided. It is simply not a part of Kupiec’s teachings. Therefore, it is respectfully submitted that the alleged motivation for combining the references, as suggested in the Office Action, is simply inapplicable.

In addition, one of ordinary skill in the art confronted with a problem of disambiguating words spoken or handwritten would never have turned to Anderson, which deals with outputting word definitions by audio or text and has nothing to do with speech recognition.

Based on at least the foregoing reasons, Applicant respectfully submits that the combination of Kupiec and Anderson fails to disclose all of the claimed elements as arranged in claim 1. Therefore, the combination of Kupiec and Anderson clearly cannot render the present invention as recited in claim 1 obvious. Thus, Applicant respectfully submits that claim 1 is allowable, and respectfully requests that the Examiner withdraw the § 103(a) rejection of claim 1. In addition, claims 2-6 are patentable at least by virtue of their dependency on claim 1.

B. Claims 7-9

The Examiner rejected claims 7-9 under 35 U.S.C. § 103(a) as being unpatentable over Kupiec in view of Anderson and U.S. Patent No. 6,138,100 to Dutton et al. (hereinafter "Dutton"). Applicant respectfully traverses this rejection with respect to the dependent upon claim 1, claims 7-9. Applicant has already demonstrated that Kupiec and Anderson do not meet all the requirements of independent claim 1. Dutton is relied upon only for its teaching of mobile phones (see pages 9-10 of the Office Action).

In general, Dutton teaches defining an interface for a system using voice commands to connect a first user to a second user over a network. The interface receives a request to define the interface for a particular user. The interface receives a first information item, and searches at least one database for a second information item indexed by the first information item. Another search is performed for a third information item indexed by the second information item. This process is continued until the interface has gathered sufficient information items to construct a natural language grammar for use by the interface. The interface uses the natural language

grammar to parse commands given by the user for future communications connections, see

Abstract.

However, Dutton only teaches allowing the user to enter information using a telephone keypad or by a voice entry (col. 7, lines 10 to 22); the reference fails to teach or suggest attempting to determine how the user is connected to this Voice Activated Connection system. Dutton only teaches accepting user input in either form; no determination is being made. Moreover, once user inputs initial information, the VAC system begins searching all available resources; it fails to further query the user based on what type of input was made or based on the type of the connection link with the user. That is, Dutton teaches accepting voice based or text based input, but no determinations are made.

Clearly, Dutton does not compensate for the above-identified deficiencies of Kupiec and Anderson. Together, the combined teachings of these references would not have (and could not have) led the artisan of ordinary skill to have achieved the subject matter of claim 1. Since claims 7-9 are dependent upon claim 1, they may be patentable at least by virtue of their dependency.

C. Claims 10-12

The Examiner rejected claims 10-12 under 35 U.S.C. § 103(a) as being unpatentable over Kupiec in view of Anderson and further in view of U.S. Patent No. 5,638,425 to Meador III et al. (hereinafter "Meador"), cited in the background section of the present Application. Applicant respectfully traverses this rejection with respect to the dependent upon claim 1, claims 10-12. Applicant has already demonstrated that Kupiec and Anderson do not meet all the requirements

of independent claim 1. Meador is relied upon only for its teaching of asking the user to spell out unrecognized voice input, having a contact directory and Boolean searching (see pages 10-12 of the Office Action).

Meador only teaches allowing the user to spell out unrecognized user input first by speaking the letters but if this fails, then the user may key in the letters (col. 4, lines 20 to 40). Meador does not teach or suggest attempting to determine how the user is connected to this mechanized directory assistance system. In fact, no determinations about the connection link is being made and the user always attempts to communicate the initial request by speaking.

Clearly, Meador does not compensate for the above-identified deficiencies of Kupiec and Anderson. Together, the combined teachings of these references would not have (and could not have) led the artisan of ordinary skill to have achieved the subject matter of claim 1. Since claims 10-12 are dependent upon claim 1, they may be patentable at least by virtue of their dependency.

D. Claim 13

The Examiner rejected claim 13 under 35 U.S.C. § 103(a) as being unpatentable over Kupiec in view of Anderson, Meador and further in view of U.S. Patent No. 6,240,448 to Imielinski et al. (hereinafter "Imielinski"). Applicant respectfully traverses this rejection with respect to the dependent upon claim 1, claim 13. Applicant has already demonstrated that Kupiec, Anderson and Meador do not meet all the requirements of independent claim 1 (see Arguments above with respect to claims 10-12, § IV.C). Imielinski is relied upon only for its teaching of hierarchy of contact point types (see page 12 of the Office Action).

In general, Imielinski is directed to allowing the user to access world wide web via audio pages. In Imielinski, the user inputs the request via keypad of a telephone or via speaking a command (e.g. column number and then row number of the requested data on the page), see col. 3, lines 5 to 45. Clearly, Imielinski does not teach or suggest attempting to determine how the user is connected to this mechanized directory assistance system. In fact, no determinations about the communication links are made.

Moreover, there is no motivation to combine **these four references** in the manner suggested by the Examiner. In particular, the Examiner asserts that one of ordinary skill in the art would have been motivated to combine Imielinski in order to make the appearance of the response agree with the query (page 12 of the Office Action). However, Anderson already teaches speaking information to the user as opposed to just providing it as text. Therefore, there is no motivation to combine Anderson and Imielinski together with Kupiec and Meador in the manner suggested by the Examiner.

Clearly, Imielinski does not compensate for the above-identified deficiencies of Kupiec, Anderson and Meador. Together, the combined teachings of these references would not have (and could not have) led the artisan of ordinary skill to have achieved the subject matter of claim 1. Since claim 13 is dependent upon claim 1, it may be patentable at least by virtue of its dependency.

E. Claims 14

The Examiner rejected claim 14 under 35 U.S.C. § 103(a) as being unpatentable over Kupiec in view of Anderson and Meador. Applicant respectfully traverses this rejection with

respect to the dependent upon claim 1, claim 14. Applicant has already demonstrated that Kupiec, Anderson and Meador do not meet all the requirements of independent claim 1 (see Arguments above §§ IV.A & C). These arguments apply with equal force herein. Therefore, Applicant respectfully requests the Examiner to withdraw this rejection of claim 14, which depends upon claim 1.

F. Claims 15-16

The Examiner rejected claims 15-16 under 35 U.S.C. § 103(a) as being unpatentable over Kupiec in view of Anderson and further in view of U.S. Patent No. 6,581,055 to Ziauddin et al. (hereinafter "Ziauddin"). Applicant respectfully traverses this rejection with respect to the dependent upon claim 1, claims 15-16. Applicant has already demonstrated that Kupiec and Anderson do not meet all the requirements of independent claim 1. Ziauddin is relied upon only for its teaching of a question unit having a number of questions (see page 13 of the Office Action). In general, Ziauddin only deals with optimizing database queries and has nothing to do with audio systems. Ziauddin does not teach or suggest attempting to determine how the user is connected to a database interface.

Moreover, there is no motivation to combine these references in the manner suggested by the Examiner. In particular, the Examiner asserts that one of ordinary skill in the art would have been motivated to combine Ziauddin so as to minimize user efforts (page 13 of the Office Action). However, one of ordinary skill in the art would never have consulted Ziauddin when dealing with a problem of Anderson's audio dictionary or Kupiec's transcribing speech or handwriting into a computer readable signal. Ziauddin not only addresses a different problem

but is also from a different field of endeavor. Therefore, there is no motivation to combine Kupiec, Anderson and Ziauddin in the manner suggested by the Examiner.

Clearly, Ziauddin does not compensate for the above-identified deficiencies of Kupiec and Anderson. Together, the combined teachings of these references would not have (and could not have) led the artisan of ordinary skill to have achieved the subject matter of claim 1. Since claims 15-16 dependent upon claim 1, they may be patentable at least by virtue of their dependency.

G. Claim 17

The Examiner rejected claim 17 under 35 U.S.C. § 103(a) as being unpatentable over Kupiec in view of Anderson, Ziauddin et al. and further in view of U.S. Patent No. 5,625,748 to McDonough et al. (hereinafter "McDonough"). Applicant respectfully traverses this rejection with respect to the dependent upon claim 1, claim 17. Applicant has already demonstrated that Kupiec, Anderson and Ziauddin do not meet all the requirements of independent claim 1. McDonough is relied upon only for its teaching of interface operable to connect to the human operator (see page 14 of the Office Action). Clearly McDonough does not compensate for the above-identified deficiencies of Kupiec, Anderson and Ziauddin. Together, the combined teachings of these references would not have (and could not have) led the artisan of ordinary skill to have achieved the subject matter of claim 1. Since claim 17 depends upon claim 1, it may be patentable at least by virtue of its dependency.

H. Claim 18

The Examiner rejected claim 18 under 35 U.S.C. § 103(a) as being unpatentable over Kupiec in view of Anderson, Meador and Ziauddin. Applicant respectfully traverses this rejection with respect to the dependent upon claim 1, claim 18. Applicant has already demonstrated that Kupiec, Anderson and Meador do not meet all the requirements of independent claim 1 (see Arguments above §§ IV.A & C) and Applicant has already demonstrated that Kupiec, Anderson and Ziauddin do not meet all the requirement of independent claim 1 (see Arguments above §§ IV.F). All of these arguments apply with equal force herein. Therefore, Applicant respectfully requests the Examiner to withdraw this rejection of claim 18 in view of its dependency on claim 1.

I. Claims 19-20

The Examiner rejected claims 19-20 under 35 U.S.C. § 103(a) as being unpatentable over Kupiec in view of Anderson and Meador. Applicant respectfully traverses this rejection with respect to the dependent upon claim 1, claims 19-20. Applicant has already demonstrated that Kupiec, Anderson and Meador do not meet all the requirements of independent claim 1 (see Arguments above §§ IV.A & C). These arguments apply with equal force herein. Therefore, Applicant respectfully requests the Examiner to withdraw this rejection of claims 19-20, which depend upon claim 1.

J. Claim 21

The Examiner rejected claim 21 under 35 U.S.C. § 103(a) as being unpatentable over Kupiec in view of Anderson. Applicant respectfully submits that claim 21 is patentable at least by virtue of its dependency on claim 1.

K. Claim 22

The Examiner rejected claim 22 under 35 U.S.C. § 103(a) as being unpatentable over Kupiec in view of Anderson, Meador and further in view of U.S. Patent No. 4,612,416 to Emerson et al. (hereinafter "Emerson"). Applicant respectfully traverses this rejection with respect to the dependent upon claim 1, claim 22. Applicant has already demonstrated that Kupiec, Anderson and Meador do not meet all the requirements of independent claim 1 (see Arguments above §§ IV.A & C). Emerson is relied upon only for its teaching of inserting identification of the caller in the header of the message (see page 17 of the Office Action). Clearly Emerson does not compensate for the above-identified deficiencies of Kupiec, Anderson and Meador.

The Examiner asserts that one of ordinary skill in the art would have been motivated to combine the references so as to identify the message before opening it for processing (page 18 of the Office Action). Applicant respectfully disagrees. There is no motivation to combine the four references in a manner suggested by the Examiner. The primary reference cited by Examiner, Kupiec deals with filtering speech input and presenting user with documents discovered based on that input. Anderson deals with providing voice dictionary for words shown on a page. Meador teaches a directory assistance system, where the user is provided with the requested phone

number. None of the three references teaches or suggests having any messages at all; therefore, there is no need for a header which identifies the message. Applicant respectfully submits that these four references are simply not combinable in a manner indicated by the Examiner.

In addition, Emerson is in a completely different field of endeavor from the other references; therefore, one of ordinary skill in the art confronted with a problem of the Kupiec, Anderson or Meador would not have turned to a reference like Emerson, which deals with messaging services. Clearly, together, the combined teachings of these references would not have (and could not have) led the artisan of ordinary skill to have achieved the subject matter of claim 1. Since claim 22 depends upon claim 1, it may be patentable at least by virtue of its dependency.

L. Claim 23

The Examiner rejected claim 23 under 35 U.S.C. § 103(a) as being unpatentable over Kupiec in view of Anderson, Meador and Dutton. Applicant respectfully traverses this rejection with respect to the dependent upon claim 1, claim 23. Applicant has already demonstrated that Kupiec, Anderson and Meador do not meet all the requirements of independent claim 1 (see Arguments above §§ IV.A & C) and Applicant has already demonstrated that Kupiec, Anderson and Dutton do not meet all the requirements of independent claim 1 (see Arguments above § IV.B). All of these arguments apply with equal force herein. Therefore, Applicant respectfully requests the Examiner to withdraw this rejection of claim 23, which depends upon claim 1.

M. Claim 24

The Examiner rejected claim 24 under 35 U.S.C. § 103(a) as being unpatentable over Kupiec in view of Anderson, Meador and Emerson. Applicant respectfully traverses this rejection with respect to the dependent upon claim 1, claim 24. Applicant has already demonstrated that Kupiec, Anderson, Meador and Emerson do not meet all the requirements of independent claim 1 (see Arguments above § IV.K). All of these arguments apply with equal force herein. Therefore, Applicant respectfully requests the Examiner to withdraw this rejection of claim 24, which depends upon claim 1.

N. Claims 25-27

The Examiner rejected claims 25-27 under 35 U.S.C. § 103(a) as being unpatentable over Kupiec in view of Anderson and further in view of Applicant's allegedly admitted prior art (hereinafter "Admitted Prior Art"). Applicant respectfully traverses this rejection with respect to the dependent upon claim 1, claims 25-27. Applicant has already demonstrated that Kupiec and Anderson do not meet all the requirements of independent claim 1. Applicant's Admitted Prior Art does not compensate for the above-identified deficiencies of Kupiec and Anderson. Together, the combined teachings of these references would not have (and could not have) led the artisan of ordinary skill to have achieved the subject matter of claim 1. Since claims 25-27 depends upon claim 1, they may be patentable at least by virtue of their dependency.

O. Claims 28-29

The Examiner rejected claims 28 and 29 under 35 U.S.C. § 103(a) as being unpatentable over Kupiec in view of Anderson. Applicant respectfully submits that claims 28 and 29 are patentable at least by virtue of their dependency on claim 1.

P. Claims 30-33

The Examiner rejected claims 30-33 under 35 U.S.C. § 103(a) as being unpatentable over Meador in view of Admitted Prior Art on page 27 of the Specification. Applicant respectfully traverses this rejection in view of the following comments. Of these claims, only claim 30 is independent. Independent claim 30 recites a number of novel features not taught by the prior art. For example, claim 30 recites a geographical location data ...usable in search queries to obtain an associated location and the location system operable to receive location data from the location database in response to a query involving personal identification data.

The Examiner alleges that Meador's voice processing unit (VPU) 114 requesting the street number is equivalent to obtaining geographical location data usable to obtain an associated location as set forth in claim 30 and that Applicant's Admitted Prior Art teaches a location system and positioner as set forth in claim 30 (see page 21 of the Office Action). Applicant respectfully disagrees with the Examiner.

Meador's VPU requests the street location if the directory database pulls up more than one telephone number (Fig. 6; col. 8, lines 50 to 63). In particular, Meador uses the street locations for differentiating between different names and not to obtain an associated location. That is, in Meador, the user is queried for a street location to provide the desired telephone number as opposed to being queried for personal information to obtain a location for that person.

The Admitted Prior Art, on the other hand, only teaches a conventional GPS system. It too fails to teach or suggest using personal data to obtain associated location for determining a

route. That is, the Admitted Prior Art does not teach or suggest a location system, which receives a location from a database based on a query involving personal identification data.

Moreover, the Examiner is exercising impermissible hindsight in attempting to combine Admitted Prior Art and Meador. Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be “clear and particular.” Winner International Royalty Corporation v. Ching-Rong Wang, 202 F.3d 1340, 1348, 53 USPQ2d 1580, 1586-87 (Fed. Cir. 2000). Conclusory statements such as common knowledge to one skilled in the art or common sense do not fulfill the agency’s obligation. In re Sang Su Lee, 277 F.3d 1338, 1345 - 46, 61 U.S.P.Q.2d 1430, 1438 (Fed. Cir. 2002).

A critical step in analyzing the patentability of claims pursuant to section 103(a) is *casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field*, emphasis added. See In re Kotzab, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (citing In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one “to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.” Kotzab, 55 USPQ2d at 1316 (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Hindsight has repeatedly been held to be improper and ineffective in supporting an argument of *prima facie* obviousness. *See, e.g., In re Fritch*, 23 USPQ2d 1780 (Fed. Cir. 1992); *In re Bond*, 15 USPQ2d 1556 (Fed. Cir. 1990); *In re Laskowski* 10 USPQ2d 1397 (Fed. Cir. 1989). On the present record, the references simply do not provide the impetus to do what the inventors did. Meador is targeted to providing a phone number directory only, where various information is used to obtain the desired number (e.g., street location). Admitted Prior Art only teaches a conventional GPS, no personal data is used. Therefore, there is no suggestion or motivation to combine the reference and Admitted Prior Art.

Based on at least the foregoing reasons, Applicant respectfully submits that the combination of Meador and Admitted Prior Art fails to disclose all of the claimed elements as arranged in claim 30. Therefore, the combination of Meador and Admitted Prior Art clearly cannot render the present invention as recited in claim 30 obvious. Thus, Applicant respectfully submits that claim 30 is allowable, and respectfully requests that the Examiner to withdraw the § 103(a) rejection of claim 30. In addition, claims 31-33 are patentable at least by virtue of their dependency on claim 30.

Q. Claims 34-35

The Examiner rejected claims 34-35 under 35 U.S.C. § 103(a) as being unpatentable over Meador in view of Admitted Prior Art and further in view of Anderson. Applicant respectfully traverses this rejection with respect to the dependent upon claim 30, claims 34-35. Applicant has already demonstrated that Meador and the Admitted Prior Art do not meet all the requirements of independent claim 30. Anderson is relied upon only for its teaching of providing output in audio

or text data. It clearly fails to compensate for the above-identified deficient teachings of Meador and Admitted Prior Art.

Moreover, there is no motivation for combining these references in the manner suggested by the Examiner. There is no ROM taught in Meador or the Admitted Prior Art. Therefore, one of ordinary skill in the art would not have combined Anderson to keep the ROM requirements low. In short, together, the combined teachings of these references would not have (and could not have) led the artisan of ordinary skill to have achieved the subject matter of claim 30. Since claims 34-35 are dependent upon claim 30, they may be patentable at least by virtue of their dependency.

R. Claims 36-38

The Examiner rejected claims 36-38 under 35 U.S.C. § 103(a) as being unpatentable over Meador in view of the Admitted Prior Art. Applicant respectfully submits that claims 36-38 are patentable at least by virtue of their dependency on claim 30.

S. Claims 39-40

The Examiner rejected independent claim 39 under 35 U.S.C. § 103(a) as being unpatentable over Anderson in view of Kupiec. Claim 39 recites a similar limitation to the recitation of an automatic question unit operable to determine whether a user is connected via at least one of a voice-based and a text-based communication link recited in claim 1. Since claim 39 contains features that are similar to the features argued above with respect to claim 1, those arguments are respectfully submitted to apply with equal force here. For at least substantially the

same reasons, therefore, Applicant respectfully requests the Examiner to withdraw this rejection of independent claim 39.

Furthermore, the Examiner rejected claim 40, which depends on claim 39, under 35 U.S.C. § 103(a) as being unpatentable over Anderson in view of Kupiec and further in view of U.S. Patent No. 5,265,014 to Haddock et al. (hereinafter "Haddock"). Applicant has already demonstrated that Kupiec and Anderson do not meet all the requirements of independent claim 1. Haddock only teaches a multi-modal user interface (accepts referential and textual input) for removing a referential ambiguity from a natural language and it does not compensate for the above-identified deficiencies of Kupiec and Anderson. Together, the combined teachings of these references would not have (and could not have) led the artisan of ordinary skill to have achieved the subject matter of claim 39. Since claim 40 depends upon claim 39, it may be patentable at least by virtue of its dependency.

VI. Claim Rejections under 35 U.S.C. § 102(b)

The Examiner rejected claims 41-45 under 35 U.S.C. § 102(b) as being anticipated by Kupiec. Applicant respectfully traverses this rejection and respectfully requests the Examiner to reconsider this rejection in view of the comments, which follow.

Of these claims only claim 41 is independent. Independent claim 41 recites a number of novel features including for example receiving instructions in said communication mode for entering query items to form a database search query. The Examiner asserts that claim 41 is directed to a method of remotely reading a database and is anticipated by Kupiec. The Examiner asserts that Kupeic's hypothesis generator 260 producing hypothesis is equivalent to receiving

instruction for entering query items to form a search query as set forth in claim 41 (see page 27 of the Office Action). Applicant respectfully disagrees with the Examiner. Applicant has carefully studied Kupiec's discussion of the hypothesis generator 260 producing hypotheses 360 (possible interpretations of the user words), which is not similar to receiving instructions in said communication mode for entering query items to form a database search query as set forth in claim 41.

Applicant respectfully points out that Kupiec only teaches hypothesis generator 260, which can make use of the alternative transcriptions produced by the transcriber 250 to generate additional possible interpretations of the words of the user's question 301.

However, Kupeic only teaches receiving an original question and then generating various interpretations from this question. Kupeic fails to teach or suggest receiving further instructions for entering query items. That is, Kupeic only teaches receiving one original user request and transcribing it to various interpretations to form a number of hypotheses. Kupiec has no additional instructions received. In short, Kupeic operates based on the assumption that user input is reasonable; it adopts a co-occurrence approach. This reference fails to teach or suggest a hierarchical approach to obtaining results from a database.

Therefore, *receiving instructions in said communication mode for entering query items to form a database search query* as set forth in claim 41 is not suggested or taught by Kupeic, which lacks receiving addition instruction for entering query items to form a query. For at least these reasons, Applicant respectfully submits that independent claim 41 is patentably distinguishable from Kupeic. Applicant, therefore, respectfully requests the Examiner to

reconsider and withdraw this rejection of independent claim 41. Also, Applicant respectfully submits that claims 42-45 are allowable at least by virtue of their dependency on claim 41.

VII. New Claim

In order to provide more varied protection, new claim 46 is added. Claim 46 is patentable at least by virtue of its dependency on claim 41. In addition, claim 46 is clearly patentable at least because it further recites that the database is searched by using names, whereas in Kupiec, the documents are searched based on keywords. As a result, claim 46 is clearly patentable over Kupiec for at least this additional reason.

VIII. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.


Amendment Under 37 C.F.R. § 1.111
U.S. Application No.: 09/820,865

Attorney Docket No.: Q62688

Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. 19-4880.

Respectfully submitted,

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